

AMENDMENTS TO THE DRAWINGS:

Subject to the approval of the Examiner, Applicants propose to amend Figure 3 to change the reference character "2" to "3," and to change reference character "33" in the lower right-hand portion of this figure to "31." These changes are to correct typographical errors and are indicated in the attached drawing Replacement Sheet 1/1.

Attached: Drawing Replacement Sheet 1/1.

REMARKS

Applicants submit this Amendment in reply to the Office Action mailed July 28, 2006. In this Amendment, Applicants have amended claim 12, 30, and 31 to improve clarity and amended Figure 3 to correct typographical errors. Claims 12-31 remain pending.

In the Office Action, the Examiner provisionally rejected claims 12-31 under nonstatutory obviousness-type double patenting as being unpatentable over claims 20, 21, and 24-33 of copending U.S. Patent Application No. 10/518,715 ("the '715 Application"). Further, the Examiner rejected claims 12, 18, 22, 24, 26, 28, 30, and 31 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 4,160,234 to Karbo et al. ("Karbo"); rejected claims 19, 21, 23, 25, 27, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Karbo in view of U.S. Patent No. 6,199,575 to Widner ("Widner"); and objected to claims 13-17 as containing allowable subject matter but being dependent upon a rejected base claim.

Applicants gratefully acknowledge the Examiner's indication that claims 13-17 contain allowable subject matter. (See Office Action, page 5).

Subject to the approval of the Examiner, Applicants propose to amend Figure 3 to change reference character "2" to "3," and to change reference character "33" in the lower right-hand portion of this figure to "31." These changes are intended to correct typographical errors and are indicated in the attached drawing Replacement Sheet 1/1. Applicants respectfully request that these drawing changes be entered.

Further, Applicants note that independent claims 12, 30, and 31 have been amended to recite “wherein the capacitor comprises two plates moving with respect to each other in response to the mechanical stresses.” Support for these amendments can be found in the Applicants’ specification at, for example, page 16, ll. 1-16 and Figure 5.

Double Patenting Rejections

Applicants respectfully traverse the Examiner’s provisional rejection of claims 12-31 under of nonstatutory obviousness-type double patenting as being unpatentable over claims 20, 21, and 24-33 of copending ‘715 Application. Applicants note the double patenting rejection is premature and should be held in abeyance, at least until the copending ‘715 Application matures into a patent.

Moreover, Applicants submit that claim 12 is not obvious over claims 20, 21, and 24-33 of the ‘715 Application. In particular, claim 12 recites “wherein the electrical energy generating device is capable of supplying electrical energy to the sensing device,” whereas claim 21 of the ‘715 Application, for example, recites “wherein the electrical energy generating device is capable of supplying electrical energy to the processing unit” and “wherein the electrical energy generating device is capable of supplying electrical energy to the transmitting device.” Thus, claim 12 is patentably distinct over the claims 20, 21, and 24-33 of the ‘715 Application. Further, claims 13-31 are patentably distinct over claims 20, 21, and 24-33 of the ‘715 Application at least due their dependence from claim 10.

Accordingly, Applicants respectfully submit that the Examiner’s double patenting rejections are improper and should be withdrawn.

Claim Rejection Under 35 U.S.C. § 102(b)

Applicants respectfully traverse the Examiner's rejection of claims 12, 18, 22, 24, 26, 28, 30, and 31 under 35 U.S.C. § 102(b) as being anticipated by Karbo. In order to properly establish that Karbo anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Regarding amended claims 12, 30, and 31, Karbo at least fails to teach "a device for generating electrical energy . . . wherein the electrical energy generating device comprises a capacitor, the capacitor being charged with electrical energy in response to mechanical stresses applied to the tyre . . . [and] the capacitor comprises two plates moving with respect to each other in response to the mechanical stresses." In the Office Action, the Examiner alleges that Karbo teaches a "movable unit (30) [that] comprises a device (30) for sensing the at least one characteristic parameter, . . . [and] a device (50, i.e. transducer) for generating electrical energy." Office Action, page 3, ¶ 3. (Emphasis added). Thus, the Examiner apparently contends that transmitting assembly (30) in Karbo constitutes both a movable unit and a device for sensing.

Further, the Examiner asserts that "the electrical energy generating device (50) comprises a capacitor (74) that charges itself with electrical energy in response to mechanical stress applied to the tire (10) (Abstract; Column 4, lines 17-52)." Office Action, page 4, ¶ 1.

Karbo merely discloses that "capacitor 74 . . . is the charge storage portion of the of the charge storage-release circuit 54." Col. 5, lines 27-28 (emphasis added). The charge stored in capacitor 54 results from a voltage energy output from transducer 50. Karbo fails to teach, however, that the plates of capacitor 54 are movable. Indeed, the capacitor 54 is not shown having a variable capacitance in Figure 5. Accordingly, Karbo fail to disclose the claimed "device for generating electrical energy . . . wherein the electrical energy generating device comprises a capacitor, the capacitor being charged with electrical energy in response to mechanical stresses applied to the tyre . . . [and] the capacitor comprises two plates moving with respect to each other in response to the mechanical stresses," as recited in claims amended 12, 30, and 31. (Emphasis added). As a result, the rejection of claims 12, 30, and 31 under 35 U.S.C. § 102 is improper, and claims 18, 22, 24, 26, 28 are allowable at least due to their dependence from independent claim 12.

Claim Rejection Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 19, 21, 23, 25, 27, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Karbo in view of Widner. No *prima facie* case has been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must

both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

M.P.E.P. § 2142 (8th Ed., Rev. 5, August 2006), p. 2100-125.

A *prima facie* case of obviousness cannot be established for claims 19, 21, 23, 25, 27, and 29 because, among other things, neither Karbo nor Widner, nor their combination, teaches or suggests each and every feature of Applicants' claims. In particular, the applied references fail to teach or suggest "a device for generating electrical energy . . . wherein the electrical energy generating device comprises a capacitor, the capacitor being charged with electrical energy in response to mechanical stresses applied to the tyre . . . [and] the capacitor comprises two plates moving with respect to each other in response to the mechanical stresses," as recited in amended claim 12.

The shortcomings of Karbo are discussed above. Further, Widner is silent as to an energy generating device. In fact, Widner also fails to disclose the claimed "device for generating electrical energy . . . wherein the electrical energy generating device comprises a capacitor, the capacitor being charged with electrical energy in response to mechanical stresses applied to the tyre . . . [and] the capacitor comprises two plates moving with respect to each other in response to the mechanical stresses," as recited in claims amended 12. Rather it merely discloses a capacitor 86 that responds to pressure and not mechanical stresses. See *e.g.*, col. 8, line 33-39, Figures 11 and 14.

Indeed, the Examiner does not rely on Widner for such teachings, and thus, Widner fails to cure the above-noted deficiencies of Karbo.

Accordingly, claims 19, 21, 23, 25, 27, and 29 are allowable at least due to their dependence from independent claim 12.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.



Dated: January 26, 2007

By: Reg No 43,662 for
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Attachments: Drawing Replacement Sheet 1/1